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EXAMINER

BLACKWELL, JAMES H

ART UNIT PAPER NUMBER

2176

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/730,455

Applicant(s)

SCHUBERT ET AL.

Examiner

James H Blackwell

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 17-18, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (hereinafter Miller, U.S. Patent No. 5,446,653) in view of Vogel (U.S. Patent No. 6,424,982).

In regard to independent Claim 1, Miller teaches that an insurance policy record generated by the main processor, containing a list of the insurance policy clauses and modifiers to be printed, is transmitted to the print system, e.g., via modem or on magnetic media. The print system is coupled to a printer database 25, which contains the text of all of the insurance policy clauses and endorsement clauses. The clauses identified in the insurance policy record are retrieved from the printer database, formatted, and printed by the print system 15 to provide the final, complete policy (Col. 6, lines 7-17; compare to Claim 1, "***(a) a computer communicating with an electronic database***"). Miller also teaches a main processor 13, such as a mainframe computer, interfaces with a user through a terminal 11 (Col. 51-53; compare with Claim 1, "***(b) an input device operatively connected to said computer for entering document information into said database***"). Miller does not specifically teach *a plurality of electronic indexing tags at predetermined locations within the stored document*

information and cooperating with a computer program to capture and retrieve selected portions of the document information. However, Vogel teaches a document that is parsed according to rules that identify certain break characters that when encountered parse the document into segments depending on the break character(s) encountered by the parser and the rule set that defines what to do when certain break character(s) are encountered (Col. 3, lines 66-67, Col. 4, lines 1-44; compare to Claim 1, **“(c) a plurality of electronic indexing tags at predetermined locations within the stored document information and cooperating with a computer program to capture and retrieve selected portions of the document information”**). Vogel fails to teach a *display device operatively connected to said computer for displaying the selected portions of document information apart from non-selected portions of document information.* However, Miller teaches that an insurance policy record generated by the main processor, containing a list of the insurance policy clauses and modifiers to be printed, is transmitted to the print system, e.g., via modem or on magnetic media (Col. 6, lines 7-11; compare to Claim 1, **“(d) a display device operatively connected to said computer for displaying the selected portions of document information apart from non-selected portions of document information”**). One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings of Miller and Vogel providing the benefit of having identified and extracted one or more key phrases from a document that characterized the document.

In regard to dependent Claim 2, Miller teaches a computer system that is associated with memory means that store (i) a library of insurance policy clauses, (ii) a

rule set for each insurance policy clause, (iii) a library of endorsements (i.e., modifiers), and (iv) a rule set for each endorsement (Col. 3, lines 3-10). Miller does not specifically teach a *plurality of tags are located within said document information*. However, Vogel teaches a document that is parsed according to rules that identify certain break characters that when encountered parse the document into segments depending on the break character(s) encountered by the parser and the rule set that defines what to do when certain break character(s) are encountered (Col. 3, lines 66-67, Col. 4, lines 1-44; compare to Claim 2, “... ***said document information comprises text relating to multiple different subject matters, and wherein said plurality of tags are located within said document information to capture and retrieve text relating to a desired one of said multiple different subject matters***”). One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings of Miller and Vogel providing the benefit of having identified and extracted one or more key phrases from a document that characterized the document.

In regard to dependent Claim 3, Miller fails to teach *that the contract information comprises a commercial real estate lease*. However, Miller does teach contract information that comprises an insurance policy. It would have been obvious to one of ordinary skill in the art at the time of invention would have been motivated to assume that a real estate lease and an insurance policy were both documents that consisted of a plurality of clauses and rules that helped to create a customized document providing the benefit of enabling the generation of contracts.

In regard to independent Claim 17 (and similarly to independent Claim 27), Miller teaches that an insurance policy record generated by the main processor, containing a list of the insurance policy clauses and modifiers to be printed, is transmitted to the print system, e.g., via modem or on magnetic media. The print system is coupled to a printer database 25, which contains the text of all of the insurance policy clauses and endorsement clauses. The clauses identified in the insurance policy record are retrieved from the printer database, formatted, and printed by the print system 15 to provide the final, complete policy (Col. 6, lines 7-17; compare to Claim 17 (and similarly Claim 27), **“(a) entering document information into an electronic database”**). Miller does not specifically teach *a plurality of electronic indexing tags at predetermined locations within the stored document information and cooperating with a computer program to capture and retrieve selected portions of the document information*. However, Vogel teaches a document that is parsed according to rules that identify certain break characters that when encountered parse the document into segments depending on the break character(s) encountered by the parser and the rule set that defines what to do when certain break character(s) are encountered (Col. 3, lines 66-67, Col. 4, lines 1-44; compare to Claim 17 (and similarly Claim 27), **“(b) inserting a plurality of electronic indexing tags at predetermined locations within the stored document information, the indexing tags cooperating with a computer program to capture and retrieve selected portions of the document information”**). Vogel fails to teach *displaying the selected portions of the document information to a user apart from non-selected portions of the document information*. However, Miller teaches that an insurance policy

record generated by the main processor, containing a list of the insurance policy clauses and modifiers to be printed, is transmitted to the print system, e.g., via modem or on magnetic media (Col. 6, lines 7-11; compare to Claim 17 (and similarly to Claim 27), ***“(c) displaying the selected portions of the document information to a user apart from non-selected portions of the document information”***). One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings of Miller and Vogel providing the benefit of having identified and extracted one or more key phrases from a document that characterized the document.

In regard to dependent Claim 18, Miller teaches that an insurance policy record generated by the main processor, containing a list of the insurance policy clauses and modifiers to be printed, is transmitted to the print system, e.g., via modem or on magnetic media (Col. 6, lines 7-11; compare to Claim 18, ***“... separately displaying text relating to one of multiple different subject matters discussed in the document information”***).

3. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Vogel and in further view of Shirley et al. (hereinafter Shirley, U.S. Patent No. 5,692,206).

In regard to dependent Claim 4, Miller fails to teach *said database comprises a plurality of contract abstracting fields adapted for being populated by the user based on data contained in the contract information*. However, Shirley teaches a contract generation system provides various standard contracts that can be customized with

alternative, supplemental, and additional provisions that can be utilized with the standard contract document (Col. 2, lines 11-14; compare to Claim 4, “... **said database comprises a plurality of contract abstracting fields adapted for being populated by the user based on data contained in the contract information**”). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, and Shirley providing the benefit of having automated the generation of various legal documents.

In regard to dependent Claim 5, Miller fails to teach said database comprises a plurality of separate electronic records containing a corresponding plurality of commercial real estate leases stored in said database. However, Shirley teaches a new contract folder which stores a contract document during authoring. In one embodiment, the contract authoring also has a plurality of standard contract documents stored on a computer storage media of the computer. The standard contract documents comprise at least one standard contract having a plurality of standard provisions (Col. 2, lines 37-44; compare to Claim 5, “... **said database comprises a plurality of separate electronic records containing a corresponding plurality of commercial real estate leases stored in said database**”). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, and Shirley providing the benefit of storage space for contracts.

In regard to dependent Claim 6, Miller fails to teach *the data recorded in said lease abstracting fields is selected from a data group consisting of tenant identification, landlord identification, lease term dates, leased space information, landlord costs,*

minimum rent, recurring charges, percentage rent, non-financial, contacts, lease issues, renewal options, security deposits, late fees, and estoppels. However, Shirley teaches that the user enters relevant contract data. The data entered during this step may include, for example, the names and addresses of the parties to the contract, the term of the contract, and relevant financial information (Col. 7, lines 22-25; compare to Claim 6, **"... the data recorded in said lease abstracting fields is selected from a data group consisting of tenant identification, landlord identification, lease term dates, leased space information, landlord costs, minimum rent, recurring charges, percentage rent, non-financial, contacts, lease issues, renewal options, security deposits, late fees, and estoppels"**). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, and Shirley providing the benefit of customizable standard documents.

In regard to dependent Claim 7, Miller fails to teach *generating a customized report of data contained in selected ones of the contract abstracting fields*. However, Shirley teaches that the user creates one or more redline documents 218. A redline document 218 indicates differences between two specified documents. Thus, when a redline document 218 is generated for two revisions of a single document, the redline document indicates changes (both additions and deletions) that have been made between the different versions of the document. A redline document 218 can be used for two primary purposes. First, a redline document 218 can be generated for two different versions of a single document to indicate the changes that the user is proposing. Second, a redline document 218 can be created between a standard

contract document 108 and the most recent revision of a document in the new contract folder 200 to quickly determine the particular changes that have been made to customize the present contract (Col. 7, lines 61-67; Col. 8, lines 1-9; compare to Claim 7, “... **generating a customized report of data contained in selected ones of the contract abstracting fields**”). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, and Shirley providing the benefit of having determined what changes had been made to a document.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Vogel and in further view of Jacobs et al. (hereinafter Jacobs, U.S. Patent No. 6,353,817).

In regard to dependent Claim 8, Jacobs teaches A multi-user system for creating and maintaining a knowledge base is implemented on a variety of computer systems, including single-user personal computers, networked personal computers, and data communications networks, including the Internet (see Abstract; compare to Claim 8, “... **said electronic database is accessible by multiple users at the same time via a global communications network**”). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, and Jacobs providing the benefit of having maintained a database for multiple users on a global basis.

5. Claims 9, 15, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Vogel and in further view of Kupiec (U.S. Patent No. 6,533,822).

In regard to independent Claim 9 (and similarly independent Claim 19), Miller teaches that an insurance policy record generated by the main processor, containing a list of the insurance policy clauses and modifiers to be printed, is transmitted to the print system, e.g., via modem or on magnetic media. The print system is coupled to a printer database 25, which contains the text of all of the insurance policy clauses and endorsement clauses. The clauses identified in the insurance policy record are retrieved from the printer database, formatted, and printed by the print system 15 to provide the final, complete policy (Col. 6, lines 7-17; compare to Claim 9 (and similarly Claim 19), **“(a) a computer communicating with an electronic database”**). Miller also teaches a main processor 13, such as a mainframe computer, interfaces with a user through a terminal 11 (Col. 51-53; compare with Claim 9 (and similarly to Claim 19), **“(b) an input device operatively connected to said computer for entering contract information into said database”**). Miller does not specifically teach *a plurality of electronic indexing tags at predetermined locations within the stored document information and cooperating with a computer program to capture and retrieve selected portions of the document information*. However, Vogel teaches a document that is parsed according to rules that identify certain break characters that when encountered parse the document into segments depending on the break character(s) encountered by the parser and the rule set that defines what to do when certain break character(s) are encountered (Col. 3,

lines 66-67, Col. 4, lines 1-44; compare to Claim 9 (and similarly to Claim 19), “**(c) a plurality of electronic indexing tags at predetermined locations within the stored contract information and cooperating with a computer program to capture and retrieve selected sections of the contract information**”). One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings of Miller and Vogel providing the benefit of having identified and extracted one or more key phrases from a document that characterized the document. Miller fails to teach a *section summary prepared for each of the indexed contract sections, said summary being recorded in a field electronically linked to at least one of said indexing tags, whereby a user viewing said section summary can drill down into the stored contract information to retrieve the contract section corresponding to said at least one electronically linked indexing tag*. However, Kupiec teaches an invention that generates a summary page that includes indicators that help the user find the corresponding place in the summarized document from which the summary information was extracted or to which the summary information is most related. This invention enables the user to navigate from the summary to the related locations in the document. This invention also highlights the portions of the document that have been extracted for the summary (Col. 1, lines 28-35; compare to Claim 9 (and similarly to Claim 19), “**(d) a section summary prepared for each of the indexed contract sections, said summary being recorded in a field electronically linked to at least one of said indexing tags, whereby a user viewing said section summary can drill down into the stored contract information to retrieve the contract section corresponding to said at least one electronically**”).

linked indexing tag"). One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings of Miller, Vogel, and Kupiec providing the benefit of having extracted summaries with references to their original documents. Kuipic fails to teach *a display device operatively connected to said computer for simultaneously displaying said section summary and the corresponding contract section*. Furthermore, Miller teaches that an insurance policy record generated by the main processor, containing a list of the insurance policy clauses and modifiers to be printed, is transmitted to the print system (Col. 6, lines 7-11; compare to Claim 9 (and similarly to Claim 19, ***“(e) a display device operatively connected to said computer for simultaneously displaying said section summary and the corresponding contract section”***)).

In regard to dependent Claim 15 (and similarly to dependent Claim 25), Miller fails to teach *said section summary comprises a copied portion of the tagged section of contract information*. However, Kupiec teaches the generation of a summary page that includes indicators that help the user find the corresponding place in the summarized document from which the summary information was extracted or to which the summary information is most related. This enables the user to navigate from the summary to the related locations in the document. It also highlights the portions of the document that have been extracted for the summary (Col. 1, lines 28-35; compare to Claim 15 (and similarly to Claim 25), ***“... said section summary comprises a copied portion of the tagged section of contract information”***). It would have been obvious to one or

ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, and Kupiec providing the benefit of having been able to summarize documents.

6. Claims 10-14, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Vogel and in further view of Kupiec and in further view of Shirley et al. (hereinafter Shirley, U.S. Patent No. 5,692,206).

In regard to dependent Claim 10 (and similarly to dependent Claim 20), Miller fails to teach *said database comprises a plurality of contract abstracting fields adapted for being populated by the user based on data contained in the contract information*. However, Shirley teaches a contract generation system provides various standard contracts that can be customized with alternative, supplemental, and additional provisions that can be utilized with the standard contract document (Col. 2, lines 11-14; compare to Claim 10 (and similarly to Claim 20), “... ***said database comprises a plurality of contract abstracting fields adapted for being populated by the user based on data contained in the contract information***”). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, Kupiec, and Shirley providing the benefit of having automated the generation of a legal document.

In regard to dependent Claim 11 (and similarly to dependent Claim 21), Miller fails to teach *that the contract information comprises a commercial real estate lease*, as claimed. However, Miller does teach contract information that comprises an insurance policy. It would have been obvious to one of ordinary skill in the art at the time of

invention would have been motivated to assume that a real estate lease and an insurance policy were both documents that consisted of a plurality of clauses and rules that helped to create a customized document providing the benefit of enabling the generation of contracts.

In regard to dependent Claim 12 (and similarly to dependent Claim 22), Miller fails to teach *said database comprises a plurality of separate electronic records containing a corresponding plurality of commercial real estate leases stored in said database*. However, Shirley teaches a new contract folder which stores a contract document during authoring. In one embodiment, the contract authoring also has a plurality of standard contract documents stored on a computer storage media of the computer. The standard contract documents comprise at least one standard contract having a plurality of standard provisions (Col. 2, lines 37-44; compare to Claim 12 (and similarly to Claim 22), “... ***said database comprises a plurality of separate electronic records containing a corresponding plurality of commercial real estate leases stored in said database***”). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, Kupiec, and Shirley providing the benefit of having provided storage space for legal documents.

In regard to dependent Claim 13 (and similarly to dependent Claim 23), Miller fails to teach *the data recorded in said lease abstracting fields is selected from a data group consisting of tenant identification, landlord identification, lease term dates, leased space information, landlord costs, minimum rent, recurring charges, percentage rent,*

non-financial, contacts, lease issues, renewal options, security deposits, late fees, and estoppels. However, Shirley teaches that the user enters relevant contract data. The data entered during this step may include, for example, the names and addresses of the parties to the contract, the term of the contract, and relevant financial information (Col. 7, lines 22-25; compare to Claim 13 (and similarly to Claim 23), “... ***the data recorded in said lease abstracting fields is selected from a data group consisting of tenant identification, landlord identification, lease term dates, leased space information, landlord costs, minimum rent, recurring charges, percentage rent, non-financial, contacts, lease issues, renewal options, security deposits, late fees, and estoppels***”). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, Kupiec, and Shirley providing the benefit of customizable standard documents.

In regard to dependent Claim 14 (and similarly to dependent Claim 24), Shirley teaches that the user creates one or more redline documents 218. A redline document 218 indicates differences between two specified documents. Thus, when a redline document 218 is generated for two revisions of a single document, the redline document indicates changes (both additions and deletions) that have been made between the different versions of the document. A redline document 218 can be used for two primary purposes. First, a redline document 218 can be generated for two different versions of a single document to indicate the changes that the user is proposing. Second, a redline document 218 can be created between a standard contract document 108 and the most recent revision of a document in the new contract

folder 200 to quickly determine the particular changes that have been made to customize the present contract (Col. 7, lines 61-67; Col. 8, lines 1-9; compare to Claim 14 (and similarly to Claim 24), “... ***generating a customized report of data contained in selected ones of the contract abstracting fields***”). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, Kupiec, and Shirley providing the benefit of having determined what changes had been made to a document.

7. Claims 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Vogel and in further view of Kupiec and in further view of Jacobs.

In regard to dependent Claim 16 (and similarly to dependent Claim 26), Jacobs teaches A multi-user system for creating and maintaining a knowledge base is implemented on a variety of computer systems, including single-user personal computers, networked personal computers, and data communications networks, including the Internet (see Abstract; compare to Claim 8, “... ***said electronic database is accessible by multiple users at the same time via a global communications network***”). It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Miller, Vogel, and Jacobs providing the benefit of having maintained a database for multiple users on a global basis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 703-305-0940. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
02/25/04


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER